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Why not take the shortcut? The Swiss Supreme Court's assessment of patent infringement under the doctrine of equivalence

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In the middle of the turmoil caused by Brexit and the US elections tiny Switzerland (apropos, a country with an old democracy and some experience in implementing problematic election results as well) tries to find its way as to how to approach patent infringements by equivalent means.

In a recent [decision](#), the Swiss Supreme Court (for the first time) overturned a decision of the Swiss Federal Patent Court with respect to the interpretation of patent law. Prior decisions of the Federal Patent Court that backed appellants' positions usually touched procedural issues or the parties' standing to sue.

However, the latest decision of the Federal Supreme Court in patent matters is about the doctrine of equivalence.

The patent in suit in this infringement matter is [EP 1 579 133 B1](#). It concerns a non-return valve for urinals. The patented invention claims a valve permitting liquid flow in one direction and preventing gaseous flow in the opposite direction.

Claim 1 of the patent in suit reads as follows:

1. A non-return valve,
 1. comprising an inlet section
 1. in the form of a self-supporting trough-shaped section
 2. and an outlet section,
 1. the outlet section being made of a flexible resilient material connected to the inlet section,
 2. whereby the outlet section comprises a flat flexible resilient strip with a high inherent degree of flexibility,
 3. the strip being connected with the inlet section at its upper edge;
 3. and further comprising a component that is separate from the strip
 1. providing a complementary surface against which the lower end of the flexible strip may seal.

The lower ends of one of the two versions of the attacked valves look as follows (the picture below from the Federal Patent Court's decision shows the valve upside down):



In the procedure before the Federal Patent Court, the dispute focused on the question of whether the two plastic strips of the Defendant's valve as shown above are sufficiently "separate" from each other as claimed by feature 1.3 of claim 1.

As can be seen on the picture above, the attacked valves do not have loose ends, but rather two connectors that connect the two plastic strips at their ends.

The [decision of the Federal Patent Court](#) mentions that the Judge Rapporteur issued a technical judge's expert opinion and came to the conclusion that the attacked valves infringe claim 1 of EP 1 579 133 B1 despite the connectors that connect the ends of the plastic strips of the attacked valves.

The final decision of the Federal Patent Court, which was taken by a panel of five judges, i.e. three judges with a legal background and two with a technical background (including the Judge Rapporteur), did not follow the preliminary technical opinion of the Judge Rapporteur and concluded that the attacked valves do not infringe claim 1 of EP 1 579 133 B1 (neither literally nor by equivalent means).

The Federal Patent Court's decision did not disclose whether the Judge Rapporteur held to his expert opinion or whether he changed his mind during the deliberation on the ruling.

In its judgement, the Federal Patent Court stated that the attacked valves did not literally infringe claim 1 of EP 1 579 133 B1 because the feature of claim 1 which required that the two plastic strips at the lower end of the valve were separate was not met. The Federal Patent Court then entered into the assessment of patent infringement under the doctrine of equivalence and sharpened its case law.

The Federal Patent Court held that when assessing a patent infringement by equivalent means the following questions have to be answered in the affirmative:

Does the replacing feature objectively have the same technical function as the replaced feature?

This first question was affirmed by the court in light of para. [0022], which describes

the function of the separate parts.

The second question for the assessment of an infringement by equivalent means concerns the accessibility of the fact that both technical solutions have the same technical effect. The second question was commented on by the Federal Patent Court in a headnote of the judgment. According to this headnote, the assessment of accessibility is not to be confused with the assessment of inventiveness. The starting point for the assessment of accessibility shall not be the general state of the art, but the patent in suit. Therefore it is not to be assessed whether the replaced feature is inventive in view of the state of the art.

Taking this headnote into consideration, the second question for the assessment of patent infringement under the doctrine of equivalence reads as follows according to the Federal Patent Court:

Starting from the teaching of the patent in suit, is it evident for the skilled person that the replacing feature has the same technical effect as the replaced feature?

According to the Federal Patent Court this second question has to be asked once the features have been replaced. In other words, the accessibility has to be answered by the person skilled in the art who knows the replaced feature as well as the replacing feature and their technical effects.

According to the Federal Patent Court, the third question for the assessment of a patent infringement by equivalent means is:

With due consideration of the claim language in light of the description: Would the person skilled in the art have taken the replacing feature into account as being an equivalent solution?

In the case at hand, the Federal Patent Court did not answer the second question and went straight to the third question, because the court was of the opinion that the third question must be answered negative.

According to the Federal Patent Court, the Plaintiff in the case at hand had neither asserted nor proven that there are any facts that would have caused the person skilled in the art to take the replacing feature into account as being an equivalent solution in light of the claim language and the description of the patent.

On 29 February 2016, the Plaintiff appealed the ruling of the Federal Patent Court to the Federal Supreme Court.

On 3 October 2016, the Federal Supreme Court issued its decision and overturned the Federal Patent Court's judgment.

Interestingly, the Federal Supreme Court found that the preliminary technical opinion of the Judge Rapporteur was correct and based its opinion largely on this document without knowing whether the Judge Rapporteur actually held to his preliminary opinion or had changed his mind during the deliberation in the first instance ruling.

When reading the Federal Supreme Court's decision it seems that the Federal Supreme Court referred to the preliminary technical opinion of the Judge Rapporteur even without having been asked by the appellant to do so.

The Federal Supreme Court did not speak against the language of the three questions that shall be asked when assessing patent infringement by equivalent means according to the Federal Patent Court but the Supreme Court answered those questions differently and found that the attacked valves infringe claim 1 of EP 1 579 133 B1 by equivalent means.

When affirming the third question, the language of the ruling of the Federal Supreme Court raises doubts whether it was really necessary that this matter went through the assessment of the doctrine of equivalence. The relevant paragraph of the Supreme Court ruling reads as follows (para. 6.3.2):

“However, the court of lower instance did not take into due consideration the wording of the claim, but rather referred to the description and drawings where the strips and components are construed completely separately. The wording of the claim does, however, not teach that strips and components need to be separate on the entire length; it rather teaches, that the separation of strips and components is effected in a way that they create complementary surfaces (“separate from the strip (6) providing a complementary surface”), “against which the lower end of the flexible strip (6) may seal”. The wording of the claim therewith merely requests that the flexible strip is separated from the other component until there where the sealing is effected. An entire separation of strip and component with the loose ends is not required by the wording of the claim. Based on the wording of the claim it is self-evident from the perspective of a person skilled in the art that the separation of strip and component is only necessary on a sufficient length until the lower end where it is sealed.”

When reading this paragraph one gets the impression that the case could also have been decided under the doctrine of literal infringement without going through the lengthy assessment of an infringement by equivalent means.

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This entry was posted on Tuesday, November 15th, 2016 at 12:45 pm and is filed under literally fulfil all features of the claim. The purpose of the doctrine is to prevent an infringer from stealing the benefit of an invention by changing minor or insubstantial details while retaining the same functionality. Internationally, the criteria for determining equivalents vary. For example, German courts apply a three-step test known as Schneidmesser’s questions. In the UK, the equivalence doctrine was most recently discussed in *Eli Lilly v Actavis UK* in July 2017. In the US, the function-way-result test is used.”>Equivalents, Injunction, Mechanical Engineering, Switzerland

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